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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/046,784	03/23/1998	KAPONO D. CARTER	83000.1007	2541
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MARTINE & PENILLA, LLP 710 LAKEWAY DRIVE SUITE 170 SUNNYVALE, CA 94085			EXAMINER LUU, SY D	
			ART UNIT 2174	PAPER NUMBER

DATE MAILED: 01/29/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/046,784

Applicant(s)

CARTER, KAPONO D.

Examiner

Sy D Luu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. In view of the supplemental appeal brief filed on 9/8/03, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

- 2. Claims 1-23 are pending in this application. Claims 1, 7, 12, 17 and 23 are independent claims. This action is made Non-Final.
- 3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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5. Claims 1-4, 6-19 and 21-23 are rejected under 35 U.S.C. 102(a) as being anticipated by MicroSoft Word 97 ("Word 97").

As per claim 1, Word 97 teaches the following subject matter:

a browsing mechanism (figs. 1-7; *Word 97 providing means such as window 14 and browsing tools such as toolbar 10 and hyperlinks 12 in fig. 1, and history list 70 in fig. 7*) configured to render a current data resource (figs. 1 and 3; *e.g. data resources "Early Civilizations" and "Minos"*) in a display region of a graphical user interface (fig. 3; *display region 36*), said current data resource comprising at least one current document (figs. 1 and 3; *e.g. current document "Early Civilizations.doc" and "Minos.doc"*), said browsing mechanism configured to navigate through a plurality of data resources (figs. 1-7; *using browsing tools such as toolbar 10, hyperlinks 20 and history list 70 to navigate through a plurality of data resources such as those documents indicated by hyperlinks "Sargon", "Minos", "Gilgamesh", and "Agamemnon"*);

a selection mechanism configured to select a portion of said current document in response to a user input (fig. 3, *using the mouse pointer cursor to select the image 30, which is a portion of the currently viewed document "Minos.doc"*; fig. 4B, *using the mouse pointer cursor to select text of interest, shown as the highlighted section 45, which is also a portion of the currently viewed document "Minos.doc"*); and

an attachment mechanism configured to retrieve an attachment from said selection mechanism and attach said attachment to an e-mail message in response to a user event, said attachment associated with said portion of said current document (figs. 4A-4B and 5; *after selecting the desired portion of the currently viewed document, options "Send To" 40 and "Mail*

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Recipient" 42 are selected, resulting in the attachment 50, associated with the portion of said current document which was selected from the selection mechanism, being retrieved and attached to an e-mail message as illustrated in window 52).

As per claims 2-3, Word 97 teaches said attachment to comprise a resource locator associated with said current document (fig. 6; *resource locator 60 pointing back to the Home Page, which is associated with the current document as the hyperlink to the home page of the current document*), and source data associated with said current document (fig. 6; *source data 62*).

As per claim 4, Word 97 teaches said attachment mechanism to be configured to select an attachment type of said attachment (fig. 5; *in this instance, the attachment type is of type "doc", depicted in the body of the email as "Minos.doc"*).

As per claim 6, Word 97 teaches said browsing mechanism to be configured to navigate to a first data resource using a resource locator in a second data resource (figs. 1-7; *navigating to first data resource "Minos.doc" as presented in fig. 3 using a resource locator 12 in a second data resource "Early Civilizations.doc" as presented in fig. 1*).

Claims 7-11 are similar in scope to claims 1, 4, 2, 3 and 6 respectively, and are therefore rejected under similar rationale.

Claims 12-16 are similar in scope to claims 7-11 respectively, and are therefore rejected under similar rationale.

Claims 17-19, 21 and 23 are similar in scope to claims 1-3, 6 and 1 respectively, and are therefore rejected under similar rationale.

As per claim 22, Word 97 teaches said browsing component to further comprise: a stack configured to contain resource locators of navigated data resources (fig. 7; *history log 70 containing resource locators of previously navigated data resources*), and one or more methods configured to browse said navigated data resources by stepping forward and backward within said stack (fig. 3; *navigating means 34*).

Claim Rejections - 35 USC § 103

6. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over MicroSoft Word 97 ("Word 97").

As per claim 5, while Word 97 teaches the use of a menu option on the GUI for the attachment mechanism to initiate the e-mail attachment process (fig. 4A; *menu option 42*), Word 97 does not explicitly indicate said menu option to be a button. However, Official Notice is taken that the use of buttons as menu options is notoriously well known in the art. It would have been obvious to an artisan at the time of the invention to include the use of buttons for selecting menu options. Such an use would provide Word 97 with another choice of menu option selection design/implementation.

Allowable Subject Matter

7. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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8. The following is an examiner's statement of reasons for allowance. The prior art made of record fails to anticipate or make obvious the claimed invention. Specifically, the prior art fails to teach, in combination with the remaining elements:

the method wherein said data structure comprises a property which determines a type of said attachment, and a selection method configured to allow a user to select a value of said property as recited in claim 20.

Although Word 97 teaches a substantial amount of the claimed matters, Word 97 fails teach the specific recited limitations above. Disclosures from other prior art of record are also noted as deficient of the same recited limitations.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

9. Applicant's arguments in the communication filed 9/11/2003 with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued the following:

(a) Windows Explorer was inappropriately applied as prior art under 35 U.S.C. § 102(e) against claim 1, and should have been applied under 35 U.S.C. § 102(a);

(b) contrary to the Examiner's position, the phrase "a portion of" is clearly described in the specification in such a way as to reasonably convey to an artisan at the time of the invention;

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(c) Applicant's browsing mechanism, being incorrectly equated with a Windows Explorer window, should have been read in light of the specification;

(d) Windows Explorer, as applied according to the Examiner's position, fails to teach Applicant's selection mechanism configured to select a portion of a current document in response to user input;

(e) Windows Explorer fails to teach/suggest all of the limitations of claims 5 and 20.

The Examiner's positions regarding the above arguments are as follows:

Per (a), it was an oversight on the Examiner's part that the prior art was applied under 35 U.S.C. § 102(e) instead of under 35 U.S.C. § 102(a). However, this issue is moot in view of the new ground(s) of rejection.

Per (b), by definition "a portion of" is "a part of a whole", and "a subset of" is "a set each of whose elements is an element of an inclusive set". Although it is reasonable to assume that "a portion of" could be equated to "a subset of", however, the converse is not necessarily true. While a subset may include some elements of all elements in a set, the subset could also be all of the elements in the set according to the definition. Thus, while "a portion of" and "a subset of" may be similar in meaning, they are not necessarily the same in scope. It was according to this interpretation that the Examiner's position was established. All paragraphs in the specification that were pointed out by Applicant to describe "a portion of", contain the phrase "a subset of"; and thus would be subjected to the Examiner's interpretation as noted above, except one paragraph which describes selections made by "...user highlighted portions of a page..." For this particular instance, Applicant's argument appears to be persuasive. The rejections under 35 U.S.C. § 112 are thus withdrawn accordingly.

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Per (c), the Examiner disagrees with Applicant's statement that the claim limitation should be read in light of the specification, as well as Applicant's interpretation of the "browsing mechanism" as recited. Although the interpretation of the claim language in light of the specification is to be taken into consideration, claims should also be construed according to the "broadest reasonable interpretation", i.e. according to the "ordinary and customary" meaning of a term. In this case, a "browsing means" is defined as a means for "viewing the contents of a file or a group of files" (see page 1 of the Definition List) or similarly defined in pages 2-4 of the Definition List. Applicant argued that based on the disclosures of the specification on pages 12 and 19, the browsing mechanism of claim 1 is defined as a browsing mechanism for "browsing the web". However, according to "ordinary and customary" definition of technical terms, a browsing mechanism is not used only for browsing the web. Moreover, nowhere in the claim language can any reference to the "web", or any association of the document being associated with the web be found as asserted by Applicant. A browsing mechanism is merely a mechanism used for viewing the contents of any file or any group of files. Therefore, the browsing means as recited are still read on by Windows Explorer or Word 97, the previously and currently applied prior art respectively, in that both these references meet the requirements for providing the user a mechanism for viewing/browsing the contents of a file or a group of files.

Per (d) and (e), these issues are moot in view of the response to Applicant's arguments in (b) above.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (703) 305-0409. The

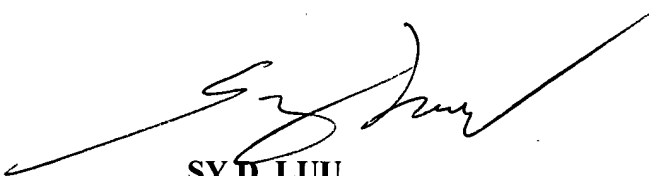
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examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST). The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Sy D. Luu', with a long horizontal stroke extending to the left.

SY D. LUU
PRIMARY EXAMINER